



PATENT
Customer No. 22,852
Attorney Docket No. 03063.0398-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hao CHEN et al.

Application No.: 09/930,705

Filed: June 29, 2001

For: SURFACE COVERINGS
CONTAINING ALUMINUM OXIDE

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated July 1, 2002, the Examiner required restriction under 35 U.S.C. § 121 between:

Group I, claims 1-13 and 31-53, drawn to a resilient surface covering; and

Group II, claims 14-30 [sic, read "29"]¹ and 54-59, drawn to a method to improve wear resistance.

The restriction requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-13 and 30-53, drawn to a resilient surface covering. As described in footnote 1, Applicants believe that the Group I surface covering claims should rightfully include the surface covering of claim 30. Applicants request that

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¹ The Examiner inadvertently included claim 30, a dependent product claim depending on claim 1, in the method claims recited in Group II.

Examiner acknowledge the inclusion of claim 30 in the elected Group I claims when these claims are examined on the merits.

Applicants further traverse the restriction requirement on the ground that the Examiner has not shown there would be a serious burden to examine together the recited resilient surface covering and method of improving wear and/or stain resistance of a resilient surface covering. As stated in M.P.E.P. § 803, "If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added). In the present case, Applicants submit that essentially all of the elements of the resilient surface covering of Group I are included within the method recited in the claims of Group II. Accordingly, a proper search for the subject matter of Group II would necessarily encompass the search for the subject matter of Group I.

In view of the foregoing remarks, Applicants believe the restriction requirement to be in error and respectfully request reconsideration the requirement be withdrawn. Alternatively, if the Examiner maintains the restriction requirement and the elected product claims are subsequently deemed allowable, in accordance with MPEP 821.04, Applicants expect that the Examiner will rejoin the non-elected method claims, which include the elements of the allowed product. (See MPEP 821.04, which states, in relevant part, "[I]f applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined").

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: July 31, 2002

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